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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,434	11/15/1999	ADAM W. FINGERMAN	FINGERMAN1-1-1	2945

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08/31/2004

FITCH EVEN TABIN & FLANNERY  
120 NORTH LASALLE STREET  
CHICAGO, IL 606033406

EXAMINER
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BRANCOLINI, JOHN R

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 08/31/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

8

# Office Action Summary

Application No.

09/440,434

Applicant(s)

FINGERMANN ET AL.

Examiner

John R Brancolini

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 9-23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 22, 23, 25 and 26 is/are allowed.
- 6) ☒ Claim(s) 9-13, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 14-18 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action in response to Amendment filed April 30, 2004. In the amendment, claims 1-8, 24, 27-33 were cancelled. Claims 9-23, 25-26 are still pending in the application.

### ***Drawings***

The drawings were received on April 30, 2004. These drawings are acceptable, and the examiner withdraws the objections to the drawings.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Wood et al. (US Patent Number 6324338), hereinafter referred to as Wood.

In regards to claim 9, Wood discloses a storage allocation method comprising:

- Receiving a request for media program storage services from a client (the client selects criteria for a show to be recorded which updates the criteria database indicating a desire to record, col 4 lines 8-15);

- Allocating a predetermined amount of client available storage capacity to the client in response to the request for media program storage services (the storage allocation device checks for sufficient disk space and allocates an amount for recording, col 4 lines 34-36);
- Receiving a request for storage of an identified media program from the client (the client can directly request a show to be recorded, col 5 lines 42-51);
- Storing the identified media program and determining an amount of client available storage capacity remaining after the storage of the identified program (the recorded show is stored in memory and the remaining space is determined (col 4 line 51, lines 34-36).

Further discussion of the claim follows in Response to Arguments section below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-13, 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood in view of Shteyn (US Patent Number 6611654).

In regards to claim 10, Wood does not directly disclose notifying the client of the amount of remaining client available storage. But Wood does show the system

calculating the remaining storage left to record another show (col 4 lines 33-35). It would have been obvious to one of ordinary skill in the art of online media recording and storage to notify the user of how much storage is remaining.

In regards to claim 11, Wood does not disclose offering additional storage capacity to the client. Shteyn however shows a system utilizing multiple servers and multiple storage devices to record the programs. It would have been obvious to one of ordinary skill in the art of online media recording and storage to offer the user additional storage space, as provided by the plurality of storage devices, in the system of Wood in view of Shteyn.

In regards to claim 12, Wood does not disclose receiving a request from the client for additional storage capacity. Shteyn however shows a system utilizing multiple servers and multiple storage devices to record the programs as requested by a client. It would have been obvious to one of ordinary skill in the art of online media recording and storage to allow the user to request additional storage space, as provided by the plurality of storage devices, in the system of Wood in view of Shteyn.

In regards to claim 13, Shteyn discloses delivering the stored media program from storage to the client (the program is streamed to the client, col 2 lines 62-66), but Shteyn does not disclose if the storage is increased after the program is delivered. It would have been obvious to one of ordinary skill in the art of online media recording and

storage to increase the allocated storage by an amount substantially equal to the storage used to store the delivered media program.

In regards to claim 19, Shteyn discloses the storage device can be a hard drive with a limited storage capacity and storage will not occur once the amount of client available storage is exceeded (col 3 lines 53-56).

In regards to claim 20, Shteyn discloses a remote storage system utilizing several servers and storage devices to record media programs. Shteyn however lacks disclosing whether additional storage space is offered to the client. It would have been obvious to one of ordinary skill in the art of online media recording and storage to offer additional space to a client once the storage space allocated to the client has been exceeded.

Further discussions of the above claims can be found in the Response to Arguments section below.

***Allowable Subject Matter***

Claims 22-23, 25-26 are allowed.

Claims 14-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

#### Applicants Arguments:

1. Claim 9, Wood does "not teach or suggest the step of receiving a request for media program service nor does it teach or suggest the step of allocating an amount of storage in response to the request for service".
2. Claim 10, there is no suggestion or motivation in Wood et al. to notify the client of remaining storage space.
3. Claim 11, no combination of Wood and Shteyn teaches allocation of additional storage space.
4. Claim 12 and 13, neither Wood nor Shteyn teach or suggest a method of pre-allocation of storage space.
5. Claim 20, no combination of Wood and Shteyn teach offering additional storage to a client.

With respect to argument 1, the examiner respectfully disagrees with applicant. Firstly, claim 9 as stated says "receiving a request for media program storage services from a client". Applicant contends that Wood does not provide a program storage service because no method of subscription is provided in Wood since no step of receiving the request is shown. However, the examiner contends that Wood clearly shows the receipt of a request for media program storage services. A user provides the system with a set of criteria, from which a set of television shows are selected which

match the criteria set forth by the client. This is seen as an attempt by the user to request media program storage. The user is making their wants known to the system, and the system responds. The fact that the request is done locally at the client location is irrelevant. The language of the claim simply says a request from a client, which Wood clearly shows. Secondly, claim 9 states "allocating a predetermined amount of client available storage capacity to the client..." Wood, which as stated by the applicant, provides a box for localized storage, which includes an allocated memory device of definite size, which is interpreted as the client storage capacity. From this initial storage capacity, Wood determines if there is room on the disk for recording of the requested show. If there is, the show is recorded and placed on the disk in the allocated storage space.

With respect to argument 2, the examiner respectfully disagrees with applicant. The applicant states that there is no suggestion or motivation in Wood to notify the client of remaining storage space. However, Wood states that when insufficient space is available, programs must be deleted in order to make space for new programs. Wood says this may be done automatically by evaluating the priority rankings of the recorded shows, however Wood also says that statistical information may be provided to the user to aid in deciding whether to watch a recorded show. The examiner contends that due to the fact that Wood maintains a calculation of available storage space, provides methods for deleting programs, and discloses providing the user with detailed



information to decide whether to watch a show, then it would be obvious to also provide the user with needed information to decide upon the deletion of a show.

With respect to argument 3, the examiner respectfully disagrees with applicant. Though neither Wood nor Shteyn disclose directly offering a user additional storage space, the examiner contends that the combination of the two would result in an obvious system where a user is given the option of requesting additional storage space. Wood provides a set-top box with a definite, limited storage capacity. Wood also discloses that once the limited storage space is completely used, then the only option is to delete data on the disk. Shteyn shows a system where space on a server can be used to record a program, and then the program can be streamed to a user at a certain location at a later time. The examiner sees a combination of the two being obvious, where once the local storage space of Wood is filled, the centralized storage space of Shteyn can be utilized as a temporary storage means until the local storage space of Wood is emptied to the point where another program can be recorded. The motivation for the combination is seen in Shteyn (col 2 lines 25-28) where it is stated that utilizing a centralized recording system contributes to a user's needs by means of shifting of recording to an alternate location, in this case a central server offering additional storage space.

With respect to argument 4, the examiner respectfully disagrees with applicant. As shown in the discussion of argument 2, the examiner believes that Wood discloses

pre-allocation of storage space. As seen in the above discussion of argument 3, the examiner also believes the combination of Wood in view of Shteyn to teach allocation of additional space, which would result from a user requesting additional storage space, as said in claim 12. With regards to claim 13, Shteyn shows that upon delivery from the centralized storage space the recorded program is removed from central storage. Additionally, with regards to returning the allocated space to client, Wood shows that once a program is removed from storage, the space is returned to the amount that the system has to store to. So, the combination of Wood in view of Shteyn would provide for removing a program from the additional storage and returning the allocated space to the client for new recording.

With respect to argument 5, the examiner respectfully disagrees with applicant. As can be seen in the discussion of argument 3 dealing with the allocation of additional storage space, the examiner believes the combination of Wood in view of Shteyn does teach providing a user with additional storage if the amount available is not enough for the recording of a certain program.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R Brancolini whose telephone number is (703) 305-7107. The examiner can normally be reached on M-Th 7am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JRB

  
Jung C. Dinh  
Primary Examiner